

18. The composition of claim 14, wherein the phosphonate is a potassium phosphonate salt.

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19. The composition of claim 14, wherein the concentration of the phosphonate is one part by weight and the concentration of the phosphate is between .001 and 1000 parts by weight.

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**Remarks**

The present invention is a fertilizer composition for plants containing phosphonate and phosphate salts and derivatives thereof, and a method of stimulating growth in plants using such a composition. This composition provides a single product which may be employed to stimulate the growth response in plants while also providing enhanced fungicidal protection.

The Office Action dated January 9, 1998, requests that the status of Ser. No. 08/705,594 filed August 30, 1996, of which the present application is a continuation-in-part application, be indicated in the specification. The applicant notes that the parent application has been allowed; however, it has not yet issued. Therefore, the status of this parent application will be appropriately updated when issuance information regarding the parent application becomes available.

The Office Action rejects claims 1 through 13 under 35 U.S.C. §112, second paragraph, as assertedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action asserts that claims 1 and 10 fail to differ in scope. Applicant respectfully disagrees that claim 1, regarding a fertilizer composition, and claim 10, regarding a fertilizer and fungicidal composition, fail to differ in scope.

However, applicant has cancelled claim 10 without prejudice. New claims 14 through 19 have been included to further define the invention and not to overcome prior art.

The Office Action also asserts that the term " $K_2HPO$ " in claim 1 should be " $K_2HPO_3$ "; that claim 7 is assertedly indefinite by allegedly failing to set forth proper Markush language; and the expression "fungicidal/fertilizer" in claim 11 is improper. Applicant has corrected each of these items by appropriate amendment.

The Office Action rejects claim 11 under 35 U.S.C. §112, first paragraph, because the specification assertedly does not reasonably provide enablement for organic salts. Applicant respectfully points out that the compositions and methods of the present invention include growth-stimulating effective amounts of both phosphate and phosphonate. (Page 1, lines 16 through 19). As defined within the specification on page 2, lines 2 through 5 and lines 16 through 17, the terms "phosphonate" and "phosphate" include both the organic and inorganic salts of the respective acid. Both organic and inorganic salts are further expressly included in page 6, lines 12 through 14. As discussed on page 18, lines 21 through 23, it is these phosphonate and phosphate groups, of which the inorganic examples are exemplary, that are the subject of the present invention. (See page 7, lines 9 through 11.) Further, the inventive compositions disclosed in the examples, including those organic salts discussed on page 16 of the specification, expressly have fertilizer effects. (See page 17, line 5).

The Office Action provisionally rejects claims 1 through 6, 10, 12, and 13, as double patenting under 35 U.S.C. § 101, as assertedly claiming the same invention as that of claims 1 through 6 of co-pending application Ser. No. 08/705,594. The claims of the present application are not claiming the same invention as that of claims 1

through 6 of the co-pending application. Claims 1 through 6 of the present application are for a fertilizer and method for stimulating growth in plants having "a growth stimulating effective amount" of certain salts in the composition or method. The co-pending application is directed toward and claims a fungicide that uses "enhanced fungicidally effective amounts" of specific salts. As pointed out on page 18, lines 21 through 23, the combination of salts claimed in the present application results in unexpected growth responses that are not a part of the co-pending application.

Therefore, claims 1 through 6 of the present application are not for the same invention as that of claims 1 through 6 of the co-pending application. If there is any double patenting, which applicant denies, then it could only be obviousness type double patenting, and, if applicant's position asserted herein does not overcome the Examiner's rejection, the applicant would then be prepared to file a terminal disclaimer. Claims 12 and 13 have been amended to depend from claim 11.

The Office Action rejects claims 7 through 9 and 11 under 35 U.S.C. § 103 (a) as being assertedly unpatentable over Widdowson et al. (article), U.S. Pat. No. 5,514,200 to Lovatt, Lovatt (article), and U.S. Pat. No. 3,798,020 to Parham, Jr. et al. The Office Action notes that the above references fail to teach specific examples of including both phosphates and phosphites together in a fertilizer, but asserts that one skilled in the art would find motivation from this prior art to combine phosphates and phosphites.

When considering prior art, the prior art reference as a whole must be considered for what it teaches. "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a

given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965). See also *Bausch & Lomb, Inc. v. Barnes-Hind Hydrocurve, Inc.*, 796 F.2d 443, 448-49, 230 USPQ 416, 419-20 (Fed. Cir. 1986) (holding that the District Court, by failing to consider a prior art reference in its entirety, ignored portions of the reference that led away from obviousness), *cert. denied* 484 US 823 (1987). “It must be remembered that the Examiner is required to consider references in their entireties, i.e., including those portions that would argue against obviousness.” *Panduit Corp. v. Dennison Mfg. Co.*, 227 USPQ 337, 345 (Fed. Cir. 1985).

The prior art must contain some suggestion or incentive that would have motivated one with skill in the art to modify a prior art reference to arrive at the present invention. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. and Int., 1986). The prior art must also indicate a reasonable expectation of success to make the modifications, determined from the vantage point of one of ordinary skill in the art at the time the invention was made. Thus, there must be both a suggestion to modify and an expectation of success found in the prior art, not in the Applicant’s disclosure, to render an invention obvious. *In re Dow Chemical Company*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). “The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modifications.” *In re Gordon*, 733 F.2d 900, 902, 221 USPQ

1125, 1127 (Fed. Cir. 1984); *see also In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990).

Lovatt '200 teaches directly away from the inclusion of phosphates in the disclosed fertilizer. "The present invention provides phosphorous fertilizers essentially devoid of phosphate." Column 3, lines 46 and 47. Lovatt '200 also teaches that phosphate fertilizers have been shown to have detrimental properties, including poor absorption through the leaves of most plant species and supporting the growth of pathogenic fungi. Thus, Lovatt '200 teaches that phosphates are undesirable for use as fertilizer. The Lovatt article cited teaches replacing phosphates with phosphites, not combining them as is done in the present invention, and teaches that phosphite is a replacement for phosphate, whereas the present invention teaches beneficially combining phosphates and phosphites. Therefore, both Lovatt '200 and the Lovatt article teach away from using the combination of phosphates and phosphites taught in the present invention.

Parham, Jr. et al. '020 teaches the use of phosphates as fertilizer and only indicates that a combination of different phosphates would be suitable as fertilizer. The use of phosphites is not discussed in Parham, Jr. et al. '020, nor is the use of phosphites in combination with phosphates suggested or even hinted at. Likewise, the Widdowson article teaches only the use of phosphate, and not phosphite, and does not contain any teaching, suggestion, or even hint of the combination of the two different salts for use as a fertilizer. As discussed above, there must be some suggestion or incentive that would have motivated one with skill in the art to combine phosphates and phosphites. Moreover, the prior art must not only suggest the combination, but also

indicate a reasonable expectation of success to make this combination, and there is no teaching, suggestion, or even hint of combining phosphate with phosphite, nor any indication that such combination would have a reasonable expectation of success, in any of the prior art stated.

When the cited prior art references are considered as a whole for what they fairly teach to one of ordinary skill in the art, they do not teach or suggest a combination of phosphates and phosphites as a fertilizer. Further, as indicated on page 18, lines 21 through 23 of the present application, the growth responses noted by the composition of the present invention were unexpected so could not have been obvious to one of ordinary skill in the art. Also, the beneficial combination of phosphates and phosphites of the present invention provides fungicidal properties, as well as growth enhancing properties, a result not even hinted at in the cited prior art. Therefore, applicant respectfully requests withdrawal of the rejection based on obviousness.

The amendments have been made to address the corrections required by the Office Action and not to address the rejections under 35 U.S.C. § 103. Applicant has added claims to more fully claim the present invention. The added claims do not contain new matter and are fully supported by the specification as filed.

A check in the amount of \$41.00 is included due to the additional independence claim.

The Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. 1.16 and 1.17 which may be required by this paper, or to credit any

overpayment, to Deposit Account 12-0600. A duplicate copy of this sheet is enclosed.

**Conclusion**

In light of the above discussion, applicant respectfully requests that claims 1 through 9, and 11 through 13, as amended, and new claims 14 through 19, are allowable and respectfully requests reconsideration and allowance of the same.

The examiner is invited to contact the undersigned at the listed telephone number if prosecution of this application may be expedited thereby.

Respectfully submitted,

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